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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,791	12/22/1999	CHARLES ROBERT KALMANEK JR.	2685/5248	5383

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EXAMINER

JAGANNATHAN, MELANIE

ART UNIT PAPER NUMBER

2666

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/469,791

Applicant(s)

KALMANEK ET AL.

Examiner

Melanie Jagannathan

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-24 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees: See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 6,483,912 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant applicant claim 1 merely broadens the scope of claims 1-5 of the patent 6,483,912 by eliminating the step of "opening a first gate at an originating network edge device based on the called party indicating acceptance for the call, opening a second gate at a terminating network edge device based on the called party indicating acceptance for the call, the reserved plurality of network resources being committed upon the first gate and the second gate being opened (claims 1-5), releasing the first gate and the second gate when the call is terminated

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by at least one from the group of the calling party and the called party (claim 4) and coordinating release of the first gate and the second gate substantially simultaneously when the call is terminated by at least one from the group of the calling party and the called party (claim 5).

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Rainu, 168 USPQ 375 (Bd. App. 1969); the omission of a reference element whose function is not needed would be obvious to one skilled in the art.

The claimed language of claim 1 merely broadens the claimed subject matter of claims 1-5 of the patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Yamato et al U.S. Patent Number 6,094,431. The claimed reserving, for at least one call, network resources associated with a first network based on an indication from a calling party and the claimed reserving, for at least one call, network resources associated with a second network based on an indication from a called party is anticipated by IP packet transfer between source terminal (Figure 1, element 111) associated with ATM network (element 129) and destination terminal (element 112) associated with ATM network (element 130) where the reservation of resources is made according to resource reservation protocol called RSVP. Also see Figure 2. The destination terminal requests resources for the IP data packets transmitted by source terminal and the data packet communication network makes the reservation of the necessary network

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resources for satisfying that request and the destination terminal transmits a reservation message (Figure 2, element 22) to the source terminal.

*Allowable Subject Matter*

3. Claims **2-10** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims **11 and 16** are allowed.

Regarding claim **11**, Yamato et al. discloses receiving a setup message from an interface unit, receiving a reserve message from an interface unit and reserving network resources according to reservation policy of first network based on received setup message and after receiving reserve message. However, the prior art of record in single or in combination, do not disclose setup message indicating a maximum limit of network resources to be reserved.

Regarding claim **16**, Yamato et al. discloses receiving a reserve message from an interface unit and reserving, for one call, network resources associated with a first network according to its own reservation policy. However, prior art of record in single or in combination, do not disclose selecting a reservation policy from a plurality of reservation policies associated with a second network, a network edge device connecting the first network to the second network and sending a backbone reserve message to the second network based on the selected backbone reservation policy, network resources associated with the second network being reserved based on the sent backbone reserve message that indicates selected reservation policy.

Additionally, all of the further limitations in claims **12-15, 17-24** are allowable since the claims are dependent upon the independent claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ikeda U.S. Patent Number 5,636,212 discloses a burst bandwidth reservation method in ATM network.

Torii et al. U.S. Patent Number 5,263,025 discloses a communication system that can execute a communication procedure necessary for setting of a communication bandwidth.

Hasegawa et al. U.S. Patent Number 5,878,029 discloses a variable-bandwidth network.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Jagannathan whose telephone number is 703-305-8078. The examiner can normally be reached on Monday-Friday from 8:00 a.m.-4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 703-308-5463. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MJ *[initials]*  
January 24, 2003

*Seema S. Rao*  
SEEMA S. RAO 1/27/03  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600